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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,483	06/29/2004	Ulrich Bohne	3012	4388
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743			EXAMINER HAMILTON, ISAAC N	
			ART UNIT 3724	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			12/29/2006	
			DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/500,483

Applicant(s)

BOHNE ET AL.

Examiner

Isaac N. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-27 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,10,11 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7-9,12-17 and 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claim 18 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: a lateral outlet opening located at the lower end of the covering is now being claimed, however, this feature is only shown in figure 1, which is a non-elected species.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 18 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “spring element” in claim 14 and “detent means” in claim 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The objections to the specification are hereby withdrawn.

***Claim Rejections - 35 USC § 112***

4. The rejections made under 35 USC 112 are hereby withdrawn, however, the amendment to the preamble has changed the scope of the claim from being a circular power saw to encompassing all machine tools.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 7-9, 12-17 and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindenmuth (5,774,992) in view of Wolf (3,565,464). Lindenmuth discloses circular power saw 2; tool 4; the covering is every element shown in the figures excluding the blade 4; adjustable residue guide shown in figure 1 and including element 7; outlet opening is at the end of element 7, which is the end not shown in figure 3; the residue guide discharges outside

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of the covering in the position shown in figure 3; the residue guide is capable of discharging inside the covering when element 7 is connected to both elements 32 and 34; pivot tube 7; pivot tube 7 is pivotable about a pivot axis, and since pivot tube 7 is pivotable in any direction, the pivot axis is an axis that is perpendicular to the direction pivot tube 7 is pivoting; feed tube 32; the residue guide is adjustable continuously due to element 7 being adjustable about an infinite number of pivot axes; when element 7 extends from element 32 to element 34 it is capable of being disposed at the top of the covering; rotary position is the position that element 7 is in at any given moment, wherein when the pivot tube is connected between elements 32 and 34, residues are carried from element 32 to the top of the covering and then in a downward direction to element 34; tool 4 rotates about an axis that is collinear with the bolt at the center of the tool in figure 3; feed tube has a slight inclination in the direction of the rotation axis, thus the feed tube and the pivot tube connected to the feed tube carry residue in a direction having a component along the rotation axis; feed tube 32 is inclined as shown in figure 1 and is substantially horizontal, wherein the longitudinal axis is collinear with the center of the outer wall of the tube; the pivot axis of the pivot tube 7 is capable of being parallel to the plane of the blade because the pivot tube can pivot about an infinite number of axes; the covering is a guard hood which covers the tool as shown in figure 3.

It would be a fair assumption that the suction tube of Lindenmuth is of the type that is flexible (pivotable) with couplings at both ends (capable of connecting 32 and 34). However, Lindenmuth does not explicitly state this, but in the art of suction hoses, Wolf shows these features. Note coupling 20 also includes rotary slide 24; the guide tube, which is the portion enclosing element 30; the connection stub, is the portion enclosing element 30; detent means 56;

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spring element 48; first rotary position is when the rotary slide 24 is connected between elements 32 and 34 of Lindenmuth; second rotary position is when the rotary slide is connected to the vacuum source; the integrated guide tube is the portion enclosing element 30; discharge opening is at the end of the guide tube adjacent element 26 which is inserted into covering portion 34, and is thus entirely located inside the covering.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The above rejection highlights that the claims are too broad. The Examiner anticipates that Applicant will have no trouble amending the claims to distinguish around the rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IH  
December 21, 2006



KENNETH E. PETERSON  
PRIMARY EXAMINER